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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY GODORF

Appeal No. 2010-001497
Application No. 09/785,094
Technology Center 2400

Oral Hearing Held: February 1, 2011

Before JOSEPH L. DIXON, LANCE L. BARRY and
JEAN R. HOMERE, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

RAY CHURCHILL, ESQUIRE
Lerner, David, Littenberg,
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The above-entitled matter came on for hearing on Tuesday, February 1, 2011 commencing at 9:03 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Paula Lowery, Notary Public.

PROCEEDINGS

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3 THE USHER: Good morning. Calendar Number 5, Appeal No. 2010-
4 001497, Mr. Churchill.

5 JUDGE DIXON: Good morning, Mr. Churchill.

6 MR. CHURCHILL: Good morning.

7 JUDGE DIXON: You have 20 minutes. You may begin when you're ready.

8 JUDGE BARRY: We'll run the timer here.

9 MR. CHURCHILL: I'm Ray Churchill from Lerner, David on behalf of the
10 Appellant in this case.

11 This case involves an invention relating to electronic music and distribution
12 of electronic music files. The technology of the application allows the user
13 to access their music files from, essentially, anywhere.

14 The idea was we wanted to provide some copyright protection to digital files
15 because they were so easily copied in the Internet environment. In this case
16 the inventor --

17 JUDGE BARRY: We were wondering if you might focus on the 112 first
18 issue.

19 MR. CHURCHILL: Certainly. There are basically two written descriptions
20 issues in this: the 112 first paragraph.

21 One of the features is this concept of having different files exclusively
22 accessible to different authentication information, and the other element of
23 this 112 rejection is having the concurrent submission of authentication
24 information with the audio file identification information before an audio
25 selection list is provided to the user.

1 The Examiner argues that these were not disclosed in the application, and we
2 disagree. It appears to us that the Examiner's opined the in haec verba
3 requirement, as opposed to actually reading what the specification describes.

4 In terms of the exclusive accessibility --

5 JUDGE BARRY: Go ahead. Computer technical difficulties.

6 MR. CHURCHILL: No matter how fast they get, you still have trouble with
7 computers.

8 JUDGE BARRY: We used to be able to get effectively two electronic pages
9 -- one on each. Lately, that feature has disappeared, so we're sort of stuck --

10 JUDGE DIXON: I can show you my hard copy.

11 MR. CHURCHILL: This concept of exclusive accessibility of the different
12 files relates to the copyright protection aspects that this inventor came up
13 with. When you had the idea of one file that everybody was accessing on
14 the Internet, it sort of violated the copyright protection.

15 Our inventor came up with this idea --

16 JUDGE HOMERE: Why don't you just show us the support instead
17 of --

18 MR. CHURCHILL: Sure. Basically, you want to take a look at Paragraph
19 31. That's probably the first place that you will describe this concept of
20 having music in separate locations, even though it's the same file. The
21 identification information access is one of those locations, but not the other.
22 So even though it's the same songs, they're in two different locations.

23 Start with Paragraph 31, and I'll actually read it to you --

24 JUDGE BARRY: Actually, Counsel, start with what is the specific
25 limitation of the claim we're talking about?

1 MR. CHURCHILL: The specific limitation: this one is the different files
2 exclusively accessible to different authentication information.

3 JUDGE BARRY: Okay.

4 MR. CHURCHILL: If we go to Paragraph 31, you'll see that the
5 specification describes that each user is assigned a unique identification code
6 such that the user, or the entity to whom the user gives the code, is the only
7 entity to upload or download music to and from the storage space allocated
8 to the user.

9 Basically, you have one set of storage space that has those files only to that
10 user. So there's that exclusive accessibility.

11 JUDGE HOMERE: Paragraph 31 you said you're reading from?

12 MR. CHURCHILL: Yes, 31. That was the first sentence from Paragraph
13 31.

14 JUDGE HOMERE: Okay.

15 JUDGE DIXON: What claim are you referring to for that language?

16 JUDGE HOMERE: Claim 52.

17 JUDGE DIXON: Claim 52?

18 MR. CHURCHILL: I have paragraph numbers. That was actually the
19 beginning of Paragraph 31.

20 JUDGE DIXON: Okay.

21 MR. CHURCHILL: We can also refer to Paragraph 34, which is on page
22 11. Here we describe that one of the advantages of the system is there's a
23 copy of a song for every user, rather than giving one copy of a song to
24 multiple users.

25 This is supporting that idea of the mutual exclusivity of the songs.

1 Moreover, the user is responsible for obtaining the songs stored in their
2 space, so this facilitates copyright owners' rights to prevent multiple
3 unauthorized parties from downloading the same song.
4 This is just going into that concept of one user accesses their music files, and
5 even though it's the same music, the same song may be in a different
6 location of that server, a different authentication information is going to get
7 access to that.

8 I think that 23 also describes this notion fairly well.

9 JUDGE DIXON: Paragraph 23?

10 MR. CHURCHILL: Paragraph 23, that's correct, on page 6. It describes the
11 user storage area is used to store the user music files uploaded by the user.
12 Preferably, each user has a predefined amount of space allocated to its sole
13 use, and no other user is permitted unauthorized access to any information
14 stored in the particular space.

15 JUDGE DIXON: So this is for the first wherein clause, right?

16 MR. CHURCHILL: That's correct.

17 JUDGE DIXON: Okay.

18 MR. CHURCHILL: The different files exclusively accessible to different
19 authentication information.

20 I think that's more than inherent as expressed, and I believe Paragraph 32 --
21 again, they harp on that notion. Paragraph 32, page 10: "after the music is
22 uploaded by the user to a central location, it may be played anywhere by any
23 device capable of connecting to the server. For example, if an online service
24 provider hosts a website, the user provides his unique identification code and
25 the online service provider authenticates the user, the user may download

1 from the Internet a copy of one or more music files that have been uploaded
2 by the user."

3 So his access information gets access to his music from anywhere.

4 JUDGE HOMERE: I think we've beaten that one to death.

5 MR. CHURCHILL: Okay. I'm surprised it was a rejection at all.

6 Then the fees -- the concurrent submission of authentication identification of
7 a user and file identification without first transmission of a song selection
8 list.

9 JUDGE BARRY: Where are we specifically looking at it? This is the last
10 wherein clause of Claim 52?

11 MR. CHURCHILL: This happens to be in Claim 52, that's correct.

12 Also in some dependent claims, like Claim 1 -- 52 to 55.

13 JUDGE BARRY: Okay.

14 MR. CHURCHILL: We can cut right to the chase, and we can look at very
15 simply -- a picture is worth a thousand words.

16 If we go to Fig. 4 and you take a look at the flow chart on the right-hand side
17 of Fig. 4 -- the path that's on that side -- reference character 222 where it
18 clearly says transmit user ID and, optionally, song ID. So we have this
19 concurrent transmission right there.

20 Some additional language -- you'll see at reference character 222 as you
21 follow that list, that's prior to the song selection list transmission.

22 As you see at step 228, after step 226 where it finds the user ID, it proceeds
23 to step 228; and it determines whether the song ID was sent. If it was sent in
24 the prior 222 step. Then, only if it wasn't sent, will it send the optional song
25 list.

1 So clearly we have a disclosure of that, and now I'll talk about how that
2 concurrent transmission of the song ID and the user
3 ID --

4 JUDGE HOMERE: So that was not to show the concurrency? That was to
5 show that it's without limitation?

6 MR. CHURCHILL: It's both, actually, it's both. It's both because in one
7 step in 222 you see that you're transmitting the user ID and the song ID.
8 That's prior to down at the bottom, step 230, which actually would
9 optionally send the list if the song ID hadn't already been sent. That's only
10 before.

11 So now let's talk about the actual paragraphs. Here in Paragraph 27: "The
12 operation of downloading music is also shown in Figure 4. This
13 embodiment the user accesses the content of the
14 server" -- let's see -- "in other words, although the user uploaded the songs
15 with one device, the user may download songs with a different device.
16 "The user accesses the website maintained by the service by using a wireless
17 modem in a manner well known to the user. The user supplies its user ID to
18 content service 70 by entering the information on a web page displayed on
19 the screen."

20 The example: "A user may identify itself as user ID, user 1. It is
21 recommended but not required that user names be more arbitrary than a
22 designated user ID for security reasons. Optionally, a song may be
23 identified at the same time as well."

24 That sounds concurrent to me.

25 Also, Paragraph 31, the second line -- in 31 we talk about each user is

1 assigned a unique identification code such that the user or the entity to
2 whom the code is given is the only entity to upload and download music to
3 and from the storage space.

4 The identification code is sent with or before the steps of unloading and
5 downloading and is used to verify that the requester is the user associated
6 with this particular storage space.

7 So, see, the “with” also identifies the concurrency.

8 JUDGE HOMERE: Okay. But how about the “without”?

9 JUDGE DIXON: Without first transmitting the song selection?

10 JUDGE HOMERE: First transmitting the song selection? That's a clear
11 negative limitation in the claim.

12 MR. CHURCHILL: That's correct, and Figure 4 clearly shows that it's not --
13 if you see that --

14 JUDGE HOMERE: I don't see anywhere in Figure 4 that precludes it
15 because, if that's the limitation, essentially it's precluding first this meeting --

16 MR. CHURCHILL: That song selection list.

17 JUDGE HOMERE: The song selection list.

18 MR. CHURCHILL: Correct.

19 JUDGE HOMERE: So is there anything in there that you can point to that
20 precludes sending out the song selection list?

21 MR. CHURCHILL: Element 230 of Figure 4 clearly says the sending of the
22 song list is optional, that is, it may not be sent.

23 JUDGE HOMERE: It says without first -- I think you've got to do more
24 than just show me an option here. You've got to show me something that
25 says, well, you can send the audio file along with the user authentication

1 information without actually sending out the song list. I don't see that there.

2 MR. CHURCHILL: I think the flow chart is identifying a list of sequential
3 steps, and if you are sending something beforehand, you are not first sending
4 to the user a list of songs that they can select and identify from.

5 JUDGE HOMERE: Well, that can mean a whole lot of things. It can mean
6 you're not sending out your home address. You're not sending out a whole
7 bunch of things. That's one of the things that could be included in there.

8 MR. CHURCHILL: Right.

9 JUDGE HOMERE: The whole universe. But reciting in there -- this is a
10 clear example of what the negative limitation looks like. What you have
11 here says by operation that's the way this system would work, okay; but
12 negatively reciting that limitation in the claim without anything in the
13 specification -- because at the end of the day, that's one of the things that's
14 going to be an issue here in this case.

15 MR. CHURCHILL: I understand.

16 JUDGE HOMERE: So if it's going to be a limitation that's going to be
17 relied upon, I would like to see some support for that in this specification.

18 MR. CHURCHILL: That's fair, and I think when you're describing a system
19 with two possibilities: one, where you are allowing the user to send their
20 authentication information, and then they check to find out if you've already
21 identified a song and it's not there; and then, optionally, they decide that
22 they're going to send you a user list, that's one of the things we taught.

23 But there's another alternative to that.

24 JUDGE HOMERE: What you're saying here really has no basis in the
25 claim. We're going way beyond what's before us. You've gone beyond

1 what's in the specification -- it's not even in the specification.

2 MR. CHURCHILL: I'm just describing what's in that drawing right now. In
3 that drawing it's two alternative approaches. There's one approach where it's
4 not going to send you a song list before you're going to send the
5 identification to their system of the name of the file.

6 JUDGE HOMERE: I don't know that we can rely on the drawing by itself to
7 support this. Do you have any discussion of that? Because look at the
8 drawing, all the drawing talks about is you submitting a user ID and,
9 optionally, a song ID; but that does not necessarily imply that they're being
10 done concurrently.

11 As a matter of fact, have you not pointed out the other portion of the
12 specification that talks about sending it optionally -- sending at the same
13 time in the specification, you'd probably be writing -- for that limitation.

14 When it comes to without first receiving a song selection -- I mean if that's
15 all you have is this drawing, I mean, we have a problem.

16 MR. CHURCHILL: I think the description of that shows those two
17 alternatives: transmitting a list first, or not transmitting a list first. Here
18 what we've claimed is the alternative where it sends the song ID, it sends the
19 authentication information without first transmitting a song selection list.

20 That's what that path is. If you follow that path in that flow chart, that's
21 exactly what's going on. That is described in Paragraph -- I believe 27,
22 where it talks about how Figure 4 is operating. That flow path.

23 JUDGE DIXON: So it's the straight down flow path?

24 MR. CHURCHILL: Yes.

25 JUDGE DIXON: That doesn't take the right side branch? The second

1 wherein clause?

2 MR. CHURCHILL: That's correct.

3 JUDGE DIXON: Okay. I just want to make sure I understand your point.

4 MR. CHURCHILL: That's correct. So you see there is a subsequent
5 optional step of sending the list of songs, but that's not the flow path that
6 we've defined here. Because it's prior to that that the song ID is transmitted
7 with the user ID.

8 JUDGE DIXON: So if that song ID is incorrect in this claim, you don't fall
9 in this claim. If you transmit it and it's not correct, you can end up in the
10 flow chart having to go through that optional song list which wouldn't be
11 without limitation.

12 MR. CHURCHILL: Presumably, they wouldn't find the song, and it
13 depends on what that confirmation step is, was the song ID sent?

14 JUDGE DIXON: You could theoretically in this claim then have -- you're
15 saying you received the ID and the song list and meet all the limitations of
16 the claim, and then when you check it you meet the claim in one situation
17 where you've met everything there; and then if it's an invalid song but a valid
18 ID, then you're not in this claim?

19 MR. CHURCHILL: It might not --

20 JUDGE DIXON: So somebody just because of a nonfunctional descriptive
21 label of a song mistyped it because they didn't have a song list --

22 MR. CHURCHILL: Right.

23 JUDGE DIXON: -- would then infringe or not infringe because of a
24 misspelling?

25 MR. CHURCHILL: That depends on the rest of the features of the claim, I

1 think, and what is done in response to that particular song selection.

2 As to this feature, I think that it's a song identification, and if that song

3 identification is sent with the user ID without getting a song selection list to

4 see what ones we can select, I think that's within the scope of the claim.

5 JUDGE DIXON: So if they mistype it, miss a word in the title, or mistyped

6 it, then you're not in the claim even though you have a valid song that's sort

7 of close -- it's the right song, but they misidentified it because they didn't

8 have a song list. Then in one case you're infringing, and in one case you're

9 not infringing? Because you're not coming through that portion of the flow

10 chart because you're saying it's optional.

11 MR. CHURCHILL: I think you're right in the sense that if you send a song

12 ID that's really not a song ID because that's not in the system, then that's not

13 in the claim. I think you're right. It must be a song ID.

14 JUDGE DIXON: A valid one.

15 MR. CHURCHILL: Well, yeah. Otherwise, it's not.

16 JUDGE DIXON: Right.

17 MR. CHURCHILL: It is, or it isn't.

18 JUDGE DIXON: Right.

19 MR. CHURCHILL: Paragraph 28 also talks about the fact that the server

20 checks to see if it's already been provided that song ID.

21 JUDGE BARRY: You have about a minute, Counsel.

22 MR. CHURCHILL: Thank you.

23 Consider Paragraph 28 also for that notion it's sending the ID before sending

24 a song selection list. Just briefly, I do not believe Van Zost, which is the

25 only reference that's been applied here, is prior art.

1 One, the Examiner takes issue with our conception data. We have an earlier
2 conception. The Examiner is only paying attention to the written notes, the
3 summary that was prepared prior to, and has wholly ignored the supportive
4 declarations that became testimony of other people who talked with the
5 inventor about what the Examiner believes to be missing from those early
6 conception documents that existed in time prior to.

7 In re: Ovshinsky requires him to look beyond just those written documents
8 and to consider the declarations as well. He's ignored the declarations.

9 We've provided sufficient evidence to meet all of the elements in
10 preconceived documents that disqualify Van Zost.

11 JUDGE DIXON: That's with respect to which claim? Does your evidence
12 go to this embodiment where the simultaneous or --

13 MR. CHURCHILL: It doesn't need to. It does go to Claim 1 and some of
14 the other independent claims which do not have that feature. That feature
15 happens to distinguish Van Zost.

16 Van Zost doesn't have this notion of transmitting both the name and user
17 name without first getting a selection list. Van Zost is all about displaying
18 what your songs are. Logging on and displaying what your songs are and
19 then picking that song from the list of ones you can actually play. That's
20 what Van Zost is about.

21 JUDGE HOMERE: That is provided that limitation is supported by the
22 specification.

23 MR. CHURCHILL: I believe it is. Under a standard that's not an in haec
24 verba standard. A standard which we all know to be what somebody skilled
25 in the art would -- I want to make sure I get this -- with a specification

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1 conveyed to the skilled artisan that he had possession of that invention.
2 If you follow that flow chart, I think you'll see that's exactly what's going on
3 in one path.

4 JUDGE DIXON: Any other questions?

5 JUDGE HOMERE: No.

6 JUDGE BARRY: No.

7 JUDGE DIXON: Thank you.

8 (Whereupon, the proceedings at 9:25 a.m. were concluded.)

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